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REMARKS

Claims 1-17 are pending in the application.

Claims 8 and 9 are original.

Claims 1-3, 5-7, 10, and 13-17 are amended.

Claims 4, 11, and 12 are canceled.

The specification is amended to insert a cross-reference to related applications after the title.

Claims 1-3, 5, 6, and 7 are amended to comply with the elected invention of Group II of the restriction requirement. Applicants note the term “(CH₂)_n heterocyclyl” is inserted into the claims in place of the deleted term “(CH₂)_n cycloalkyl” in order to claim the full scope of the elected invention of Group II in view of the description of cycloalkyl in the instant specification on page 14, at lines 13-17.

Election/Restriction

Applicants appreciate the Examiner's clarifying remarks about Groups I and II of the restriction requirement. Respectfully, Applicants maintain their traverse in order to seek further clarification of what is and is not embraced by Groups I and II.

Particularly, Applicants refer the Examiner to the term “independently” that is used in the definitions of the groups R¹, R², R³, E, A, B, R⁴, and R⁵ in Claim 1 and point out that it appears that the current description of Groups I and II do not embrace all of the compounds that are useful in Claims 1-3 and 5-7. Applicants have amended Claims 1-3 and 5-7 to define R⁴ and R⁵ as the Examiner described on page 2, last paragraph, of the Office Action. The amended claims now relate to only Group II compounds.

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However, Group II compounds seem to be those compounds wherein A and B both contain a heterocycle and R^1 , R^2 , and R^3 independently contain a heterocycle whenever they are defined as NR^4R^5 . Group I compounds seem to be those compounds wherein A and B never contain a heterocycle and R^1 , R^2 , and R^3 independently never contain a heterocycle whenever they are defined as NR^4R^5 . For example, the compounds useful in the method of original Claim 1 wherein at least one, but not all, of A, B, R^1 , R^2 , and R^3 independently contain a heterocycle do not seem to relate to the invention of Groups I or II. Also in Claim 7, species wherein one of A and B contains a heterocycle and one of A and B does not contain a heterocycle have been deleted.

Applicants respectfully request further clarification as to which invention Group relates to the compounds wherein at least one, but not all, of A, B, R^1 , R^2 , and R^3 independently contain a heterocycle are included.

Claim Objections

Claims 3, 4, and 6 are objected to because the Examiner alleged that they contained some of the non-elected Group I limitations. Claims 3 and 6 have been amended to delete the Group I limitations and Claim 4 is canceled, thereby overcoming the objection.

Claim Rejections - 35 U.S.C. § 112

(a) Claims 11 and 12 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly "data essential for treating cancers is not described in the specification."

Applicants respectfully traverse this rejection on the grounds that Claims 11 and 12 are cancelled, rendering the rejection moot.

(b) Claims 10-17 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim

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the subject matter which applicant regards as the invention. The Examiner alleged that the phrase "a compound of Formula I" has not been defined in the claims and is outside the scope of the compounds of Formula I. Applicants note that the Examiner admitted that Claim 1 has described a full description of the compound of Formula I at the bottom of page 5 of the Office Action.

Applicants respectfully traverse this rejection on the grounds that Applicants have amended Claims 10 and 13-17 to delete the phrase "Formula I" and insert instead the phrase "Claim 1." Applicants believe that the amendment does not change the meaning or scope of the claims, but only clarifies for the Examiner what was meant by the phrase "Formula I." Applicants believe that the amended Claims 10 and 13-17 are patentable under 35 U.S.C. §112, first paragraph, and that the rejection is thus overcome.

Claim Rejections - 35 U.S.C. §102

Claims 1-2, 5, and 7 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Japanese patent document number JP-405193260. The Examiner alleged that JP-405193260 discloses isophthalic acid bis-(1,3-benzodioxo-5-ylmethyl) ester.

Applicants respectfully traverse this rejection on the grounds that the compound isophthalic acid bis-(1,3-benzodioxo-5-ylmethyl) ester has been deleted from Claims 1, 2, 5, and 7. In view of this amendment, Applicants believe that Claims 1, 2, 5, and 7 are patentable under 35 U.S.C. §102(b) and that the rejection is overcome.

Claim Objections

Claims 8 and 9 are objected to as allegedly being dependent upon a rejected base claim. Applicants note that the claims would be allowable if

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rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicants respectfully traverse this rejection on the grounds that they believe that the rejections of the base claim (i.e., Claim 1) have been overcome by the above amendment and remarks. Accordingly, Applicants believe that Claims 8 and 9 are allowable in their present form without being rewritten.

Benefit of Priority Under 35 U.S.C. § 119(e)

Applicants have amended the specification to add a claim for domestic priority under 35 U.S.C. § 119(e) from United States Provisional Patent Application number 60/268,736, filed February 14, 2001. Applicants claim for domestic priority was originally made in the paper titled, "Declaration and Power of Attorney for Patent Application" that was filed with the instant specification on February 13, 2002.

Supplemental Information Disclosure Statement

Applicants bring to the Examiner's attention the Supplemental Information Disclosure Statement on Form PTO-1449 and copies of references cited that were filed on July 28, 2003, with Applicants paper dated July 24, 2003. Applicants point out to the Examiner that a copy of Form PTO-1449 with the form initialed as having been considered by the Examiner was not provided with the last Office Action. The Examiner is respectfully requested to consider carefully the references cited therein in connection with the examination of the above-identified application in accord with 37 CFR §1.104(a).

It is further respectfully requested that the references listed on the enclosed Form PTO-1449 be included in the "References Cited" portion of any patent issuing from this application (MPEP § 1302.12). A "Duplicate Copy" (1 page) of the Form PTO-1449 referenced above is transmitted with this paper for

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the Examiner's convenience. The undersigned respectfully requests the Examiner to telephone him at 734-622-1692 if the Examiner should require a duplicate copy of the art cited on the enclosed Form PTO-1449.

Applicant also bring to the attention of the Patent and Trademark Office the co-pending U.S. nonprovisional applications and the granted U.S. patent identified on the enclosed document titled, "Attachment A."

Conclusion

Applicants believe that the objections and rejections disclosed in the Office Action have been overcome and respectfully request reconsideration of Claims 1-3, 5-10, and 13-17.

The Commissioner is hereby authorized to charge any fees that may be required, or credit any overpayment, to deposit account number 23-0455.

The undersigned would welcome a telephone call from the Examiner to discuss any matters related to this case that the Examiner thinks are amenable to resolution by such discussion.

Respectfully submitted,

Date: January 22, 2004

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Enc. Duplicate copy of previously submitted Form PTO-1449 (1 page)
Attachment A(10 pages)

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ATTACHMENT A

(1) CO-PENDING U.S. NONPROVISIONAL APPLICATIONS:

APPLICANT: Dyer, et al.

SERIAL NO.: 10/071,032

FILING DATE: February 8, 2002

TITLE: Bicyclic pyrimidine matrix metalloproteinase inhibitors

APPLICANT'S DOCKET NO.: A0000425-01-CFP

APPLICANT: Barvian, et al.

SERIAL NO.: 10/075,918

FILING DATE: February 13, 2002

TITLE: Isophthalic acid derivatives as matrix metalloproteinase inhibitors

APPLICANT'S DOCKET NO.: A0000426-01-CFP

APPLICANT: Li, et al.

SERIAL NO.: 10/075,073

FILING DATE: February 13, 2002

TITLE: Fused pyrimidinone matrix metalloproteinase inhibitors

APPLICANT'S DOCKET NO.: A0000428-01-CFP

APPLICANT: Andrianjara, et al.

SERIAL NO.: 10/075,069

FILING DATE: February 13, 2002

TITLE: Matrix metalloproteinase inhibitors

APPLICANT'S DOCKET NO.: A0000434-01-CFP

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APPLICANT: Andrianjara, et al.

SERIAL NO.: 10/075,954

FILING DATE: February 13, 2002

TITLE: Quinazolines as MMP inhibitors

APPLICANT'S DOCKET NO.: A0000476-01-CFP

APPLICANT: Andrianjara, et al.

SERIAL NO.: 10/075,654

FILING DATE: February 14, 2002

TITLE: Triazolo compounds as MMP inhibitors

APPLICANT'S DOCKET NO.: A0000477-01-CFP

APPLICANT: Barvian, et al.

SERIAL NO.: 10/075,909

FILING DATE: February 13, 2002

TITLE: Pyrimidine matrix metalloproteinase inhibitors

APPLICANT'S DOCKET NO.: A0000517-01-CFP

APPLICANT: Barvian, et al.

SERIAL NO.: 10/071,073

FILING DATE: February 8, 2002

TITLE: Pyridine matrix metalloproteinase inhibitors

APPLICANT'S DOCKET NO.: A0000518-01-CFP

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APPLICANT: Sorenson

SERIAL NO.: 10/224,234

FILING DATE: August 20, 2002

TITLE: Diacid substituted heteroaryl derivatives as matrix metalloproteinase
inhibitors

APPLICANT'S DOCKET NO.: PC20500A

APPLICANT: Bunker, et al.

SERIAL NO.: 10/264,764

FILING DATE: October 4, 2002

TITLE: Alkyne matrix metalloproteinase inhibitors

APPLICANT'S DOCKET NO.: PC20536A

APPLICANT: Gaudilliere, et al.

SERIAL NO.: 10/269,197

FILING DATE: October 11, 2002

TITLE: Alkynylated fused ring pyrimidine compounds

APPLICANT'S DOCKET NO.: PC21006A

APPLICANT: Gaudilliere, et al.

SERIAL NO.: 10/384,115

FILING DATE: March 7, 2003

TITLE: Oxo-azabicyclic compounds

APPLICANT'S DOCKET NO.: PC21011A

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APPLICANT: Gaudilliere, et al.

SERIAL NO.: 10/417,073 (C-I-P of 10/384,115)

FILING DATE: April 16, 2003

TITLE: Oxo-azabicyclic compounds

APPLICANT'S DOCKET NO.: PC21011B

APPLICANT: Gaudilliere, et al.

SERIAL NO.: 10/602,160

FILING DATE: June 24, 2003

TITLE: Thiazine and oxazine derivatives as MMP-13 inhibitors

APPLICANT'S DOCKET NO.: PC25079A

APPLICANT: Johnson

SERIAL NO.: 10/634,531

FILING DATE: August 5, 2003

TITLE: Cyclic compounds containing zinc binding groups as matrix
metalloproteinase inhibitors

APPLICANT'S DOCKET NO.: PC25201A

APPLICANT: Bunker, et al.

SERIAL NO.: 10/634,709

FILING DATE: August 5, 2003

TITLE: Hetero biaryl derivatives as matrix metalloproteinase inhibitors

APPLICANT'S DOCKET NO.: PC25236A

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APPLICANT: Wilson

SERIAL NO.: 10/634,162

FILING DATE: August 5, 2003

TITLE: Fused bicyclic metalloproteinase inhibitors

APPLICANT'S DOCKET NO.: PC25239A

APPLICANT: Bunker, et al.

SERIAL NO.: 10/634,473

FILING DATE: August 5, 2003

TITLE: Isoquinoline derivatives as matrix metalloproteinase inhibitors

APPLICANT'S DOCKET NO.: PC25243A

APPLICANT: Bunker, et al.

SERIAL NO.: 10/634,289

FILING DATE: August 5, 2003

TITLE: Azaisoquinoline derivatives as matrix metalloproteinase inhibitors

APPLICANT'S DOCKET NO.: PC25244A

APPLICANT: Bunker, et al.

SERIAL NO.: 10/634,180

FILING DATE: August 5, 2003

TITLE: 3-Isoquinolinone derivatives as matrix metalloproteinase inhibitors

APPLICANT'S DOCKET NO.: PC25245A

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APPLICANT: Hicks, et al.

SERIAL NO.: 10/634,712

FILING DATE: August 5, 2003

TITLE: 6,6-Fused heteroaryl derivatives as matrix metalloproteinase inhibitors

APPLICANT'S DOCKET NO.: PC25247A

APPLICANT: Li

SERIAL NO.: 10/634,181

FILING DATE: August 5, 2003

TITLE: Fused tetrahydropyridine derivatives as matrix metalloproteinase
inhibitors

APPLICANT'S DOCKET NO.: PC25250A

APPLICANT: Roark

SERIAL NO.: 10/634,489

FILING DATE: August 5, 2003

TITLE: 5,6-Fused uracil derivatives as matrix metalloproteinase inhibitors

APPLICANT'S DOCKET NO.: PC25260A

APPLICANT: Roark

SERIAL NO.: 10/634,420

FILING DATE: August 5, 2003

TITLE: 1,6-Fused uracil derivatives as matrix metalloproteinase inhibitors

APPLICANT'S DOCKET NO.: PC25261A

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APPLICANT: Nahra, et al.

SERIAL NO.: 10/634,716

FILING DATE: August 5, 2003

TITLE: 5,6-Fused 3,4-dihydropyrimidine-2-one derivatives as matrix metalloproteinase inhibitors

APPLICANT'S DOCKET NO.: PC25266A

APPLICANT: O'Brien

SERIAL NO.: 10/634,288

FILING DATE: August 5, 2003

TITLE: 3,4-Dihydroquinolin-2-one, 5,6-fused oxazin-3-one, and 5,6-fused thiazin-3-one derivatives as matrix metalloproteinase inhibitors

APPLICANT'S DOCKET NO.: PC25268A

APPLICANT: Nahra, et al.

SERIAL NO.: 10/634,717

FILING DATE: August 5, 2003

TITLE: Phthalimide derivatives as matrix metalloproteinase inhibitors

APPLICANT'S DOCKET NO.: PC25271A

APPLICANT: Wilson

SERIAL NO.: 10/634,177

FILING DATE: August 5, 2003

TITLE: Pyridine fused bicyclic metalloproteinase inhibitors

APPLICANT'S DOCKET NO.: PC25272A

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APPLICANT: Wilson

SERIAL NO.: 10/634,290

FILING DATE: August 5, 2003

TITLE: Pyrimidine fused bicyclic metalloproteinase inhibitors

APPLICANT'S DOCKET NO.: PC25273A

APPLICANT: Li

SERIAL NO.: 10/634,182

FILING DATE: August 5, 2003

TITLE: Naphthalene derivatives as matrix metalloproteinase inhibitors

APPLICANT'S DOCKET NO.: PC25274A

APPLICANT: Hicks, et al.

SERIAL NO.: 10/634,419

FILING DATE: August 5, 2003

TITLE: Pyrimidine-2,4-dione derivatives as matrix metalloproteinase inhibitors

APPLICANT'S DOCKET NO.: PC25286A

APPLICANT: Picard

SERIAL NO.: 10/634,713

FILING DATE: August 5, 2003

TITLE: Monocyclic derivatives as matrix metalloproteinase inhibitors

APPLICANT'S DOCKET NO.: PC25298A

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APPLICANT: Picard, et al.

SERIAL NO.: 10/634,225

FILING DATE: August 5, 2003

TITLE: Pyrimidinone fused bicyclic metalloproteinase inhibitors

APPLICANT'S DOCKET NO.: PC25300A

APPLICANT: Ortwine

SERIAL NO.: 10/634,718

FILING DATE: August 5, 2003

TITLE: Chromone derivatives as matrix metalloproteinase inhibitors

APPLICANT'S DOCKET NO.: PC25319A

APPLICANT: Bunker, et al.

SERIAL NO.: 10/739,261

FILING DATE: December 18, 2003

TITLE: Amide and ester matrix metalloproteinase inhibitors

APPLICANT'S DOCKET NO.: PC25567A

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(2) GRANTED U.S. PATENT:

APPLICANT: Picard, et al.

PATENT NO.: 6,656,932

GRANT DATE: December 2, 2003

TITLE: Benzo thiadiazine matrix metalloproteinase inhibitors

APPLICANT'S DOCKET NO.: A0000489-01-CFP